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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,789	05/30/2001	Keiju Kuboki	35.C15385	5081

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EXAMINER

BEATTY, ROBERT B

ART UNIT PAPER NUMBER

2852

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,789

Applicant(s)

KUBOKI, KEIJU

Examiner

Robert Beatty

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 18-57 and 62-66 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 58 and 59 is/are allowed.
- 6) ☒ Claim(s) 7-17 and 60-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Newly submitted claims 18-57,62-66 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 18-34,62-63 are directed to an image forming apparatus having a trial copy mode with controller for prohibiting/allowing the execution of the trial copy mode.

Claims 35-51,64-65 are directed to an image forming apparatus having a trial copy mode having first and second displays for inputting data or notifying the operator.

Claims 52-57,66 are directed to an image forming apparatus having a trial copy mode and which reads image data stored in a memory using a box function.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-57,62-66 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Applicant's traversal of claims 18-57,62-66 in Paper No. 11 is acknowledged. The traversal is on the grounds that 1) there would be no undue burden on the examiner and 2) they all are related to a trial image forming mode which is controlled in accordance with a mode, instruction, or condition. This is not found

persuasive because the examiner believes there would be an undue burden in trying to find prohibition controls, display executions, and notification controls which relate to a trial copy mode in addition to the originally claimed numeric control for a trial copy mode which would require much more time and searching than in the originally presented claims. Further, it is to be noted that the newly presented claims are not even addressed in the original background and summary of the invention spanning pages 1-5.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 8-17,60-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, lines 19-20, it appears the applicant uses a double negative which just confuses this limitation. It is suggested that on both lines 19 and 20, "not" be deleted. Similar confusion exists in claim 17.

In claim 8, line 20, the applicant uses the alternative language "or" which is only permissible (i.e. without undue indefiniteness) if the two concepts linked by the alternative language are equivalents. However, it is believed that the applicant is claiming performing the second image forming operation when 1) the image forming mode is reset by the second setting operation or 2) the image forming mode is reset by the second setting operation which includes resetting the first processing

conditions which are not believed to be to be equivalents (just one seems to be much broader than the other). Similar indefiniteness occurs in claim 17.

In claim 12, the applicant claims a "fourth image forming operation" but no third image forming operation has previously been claimed which renders this claim confusing.

In claims 10 and 12, the applicant describes "third" and "fourth" image forming operations which are confusing because they are believed to be the same as the "second" image forming operation however with different limitations. In other words, the applicant implies that the third or fourth image forming operation are different than the second image forming operation which is not clear (i.e. if a print operation includes a first image forming operation which is the trial copy mode (e.g. 1 copy) and the second image forming operation is the rest of the copies (whether with or without the first and second conditions changed) than what constitutes the third or fourth image forming operations in the same print operation?)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 8-17, 60-61 are rejected under 35 U.S.C. 102(a) as being anticipated by Endo et al.

Endo et al. teach an image forming apparatus comprising an image input means 106 for scanning an original document to produce digital image data, a storage means 501, 510 for storing the digitized image data and image forming means 118 for reading the image data and forming an image onto a paper sheet. Various settings can be activated for producing a desired output such as density, duplex mode, magnification, number of sets to be produced, etc. A sample set of sheets (first image forming operation) can be formed by activating a sample set command key 209 (Fig.2). When the sample set key is activated the image forming apparatus switches to a mode wherein a set of copies are made and output to a sorter. Thereafter the image forming apparatus will enter a waiting mode which waits for an operator to either accept the output copies or change one of the settings (see col.12, line 66 – col.13, line 32). If it is accepted, then the remaining desired sets (second image forming operation) will be the one minus the originally input desired sets. If it is not accepted, then the remaining sets (second image forming operation) will be the original input desired sets. See col.25, lines 45-63. It is to be noted that the last paragraph in claims 8 and 17 can read on the second image forming operation being performed if a second setting operation resets a setting (such as magnification, etc.) which, as described above, will occur in Endo et al.

5. Claims 1-7, 58-59 are allowable over the prior art of record.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Beatty whose telephone number is 703-308-1372. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley, can be reached on (703) 308-1373. The fax phone number for the organization where this application or proceeding is assigned is 703-308-3431.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.



Robert Beatty
Primary Examiner
Art Unit 2852

May 18, 2003